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REMARKS:

- 1) Referring to item 10) of the Office Action Summary, please indicate the acceptance of the drawings filed on January 4, 2005.
- 2) In accordance with the PCT procedures, the original specification of this application was a direct literal translation of the corresponding foreign text of the PCT International Application. The specification has now been amended in an editorial and formal manner, to correct a few clerical or translation errors, and to better conform to typical US application format (for example including section headings). The editorial amendments are supported by the context of the original text, and do not introduce any new matter. Entry and consideration thereof are respectfully requested.
- 3) Also in accordance with the PCT procedures, the original claims of this application were a direct literal translation of the claims of the PCT International Application. The claims have now been amended in an editorial and formal manner to avoid the undesired style of a direct literal translation, and to better conform to typical US claim style. Also, independent claims 1 and 9 have been substantively limited by incorporating features relating to a "plurality of receivers" from original claim 7. New independent claim 19 has been drafted from the ground up in view of typical US claim form, to cover inventive subject matter with a slightly different terminology and claim style in comparison to the original translated claims. Claim 19 is

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supported by subject matter from original claims 1, 2 and 7. In view of the original support, the claim amendments and the new claim do not introduce any new matter. Entry and consideration thereof are respectfully requested.

- 4) Referring to section 2 on page 2 of the Office Action, the objection to the disclosure has been taken into account in the present amendment of the specification. Particularly, appropriate section headings have now been added. Please withdraw the objection.
- 5) Referring to section 3 on pages 2 to 3 of the Office Action, the objection to claims 1 to 4, 7 and 9 to 18 has been taken into account in the present claim amendment. The informalities noted by the Examiner have been corrected or avoided. Accordingly, please withdraw the objection to the claims.
- 6) Referring to section 5 on pages 3 and 4 of the Office Action, the rejection of claims 2, 3, 7, 10 and 12 as indefinite under 35 USC §112(2) has been addressed in the present claim amendment. The items noted by the Examiner have been avoided or corrected. The amended claims are clear and definite, and in conformance with US claim requirements. Accordingly, please withdraw the rejection of claims 2, 3, 7, 10 and 12 as indefinite.
- 7) Referring to section 7 on pages 4 and 5 of the Office Action, the rejection of claims 1 to 4 and 9 to 13 as anticipated by US Patent 6,539,852 (Ertl) is respectfully traversed.

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Independent claims 1 and 9 have been amended to incorporate a feature from original claim 7, namely that the gripper-like device comprises a plurality of receivers respectively to receive a plurality of the balancing weights. Since original claim 7 was not rejected as anticipated by Ertl, the amended independent claims 1 and 9 reciting a feature from claim 7 are not subject to the anticipation rejection. In detail, the features now recited in claims 1 and 9 are not disclosed by Ertl, as follows.

According to present amended independent claims 1 and 9, the device and method according to the present invention involve a gripper-like device comprising a plurality of receivers for receiving a plurality of balancing weights. The receivers are arranged one after another in a row in a transverse direction extending transversely relative to a longitudinal direction of the rotor. Furthermore, the receivers are jointly moveable or displaceable in the transverse direction.

With such features, the device simultaneously holds plural balancing weights in a ready state, so that any selected one of the balancing weights can be placed and fastened as needed at the balancing location on the rotor being balanced. Also, plural successive balancing weights can quickly be successively fastened to successive balancing locations on the rotor, without requiring the gripper-like device to move away from the rotor to a balancing weight loading station or the like in order to be re-supplied individually with a subsequent balancing weight. In this regard, see page 7 line 1 to page 8 line 25. More particularly, the receivers can move in the transverse direction so as to move any selected one of the balancing weights into the

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working position, for the selected balancing weight to be placed and fastened on the outer periphery of the rotor at the pertinent balancing location. Also, plural different balancing weights can be simultaneously carried by the gripper-like device, whereby the different balancing weights may be individually adapted to different shapes of the rotor, different weight values, or the like (see the specification at page 7 lines 5 to 10 and 24 to 29 and page 8 lines 4 to 19).

Ertl does not disclose such a gripper-like device that comprises a plurality of receivers for receiving a plurality of balancing weights, whereby the receivers are arranged one after another in a row in a transverse direction and the receivers are jointly movable in the transverse direction. To the contrary, Ertl discloses a device with a holding structure that holds only a single compensation weight (13) at a time, and then presses the compensation weight against an attachment surface (18) on an inner circumference of a vehicle wheel (19) so that an adhesive backing of the compensation weight adheres onto the attachment surface for compensating an unbalance of the wheel (see abstract, Figs. 1 and 2, col. 3 lines 58 to 62, etc.).

Ertl provides no disclosure and no suggestion to provide a plurality of receivers that would receive a plurality of balancing weights in the gripper-like device simultaneously. Furthermore, Ertl would not have suggested that such receivers should be arranged one after another in a transverse direction relative to the rotor, and that the receivers should be jointly moveable in the transverse direction. Ertl also gives no reason or purpose for such features. In fact, such features would not

have made sense in the context of the reference, because the Ertl apparatus fastens a compensation weight on an inner circumferential surface (18) of a wheel (19). Note that the wheel axis extends perpendicular to the plane of the drawing sheet of Fig. 1 or Fig. 3. Thus, it would not have been suggested, because it would not have been suitable or practically possible, to arrange a plurality of receivers in a row in a transverse direction relative to the wheel axis, and have these receivers movable in this transverse direction, because such a transverse direction would have been confined or obstructed within the inner circumferential surface (18) of the wheel.

For the above reasons, the inventions of independent claims 1 and 9 are not anticipated and would not have been obvious in view of the Ertl disclosure. The dependent claims are patentably distinguishable over the prior art already due to their dependence. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1 to 4 and 9 to 13 as anticipated by Ertl.

- 8) Referring to section 9 on pages 5 and 6 of the Office Action, the rejection of claims 7 and 14 to 18 as obvious over Ertl in view of JP 61-209789 (Genma) is respectfully traversed.

As discussed above, features regarding the "plurality of receivers" from original claim 7 have been incorporated into amended independent claim 1. Claim 1 has been discussed above in comparison to the disclosure of Ertl. Claims 7 and 14 to 18 depend from claim 1.

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The Examiner has acknowledged that Ertl does not suggest a plurality of receivers for receiving a plurality of balancing weights. Without support in the prior art, the Examiner has further asserted that "it would have been obvious to an artisan in the art to recognize the advantages and desirability to duplicate the receiver for each of the gripper unit for balancing weights without changing the operation and performance of the apparatus". For support, the Examiner has cited the case St. Regis Paper Co. v. Bemis Co., Inc. 193 USPQ 8 (7 Cir. 1977).

The St. Regis Paper Co. case does not seem to support the proposition. Instead, the case addresses the question whether a combination of old known elements can be a patentable invention, which it answered in the affirmative only if the combination gives a synergistic result greater than the sum of the several parts or effects taken separately. Particularly, the case involved a patent on a bag construction having four special features, of which three features were known from a prior patent, and the fourth feature relating to multiple layers of the bag was also well known in the art.

With regard to the present application, the Examiner has not shown that the arrangement of present claim 1 is merely a combination of conventionally known elements or features. Particularly, the prior art does not disclose a gripper-like device comprising a plurality of receivers for receiving a plurality of balancing weights. To the contrary, Ertl discloses only a single holding structure for holding a single compensation weight as discussed above. Also as discussed above, it would not have been suggested by Ertl to provide a plurality of receivers

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arranged one after another in a transverse direction and being movable in the transverse direction, because that would not have been practical in the context of applying the balancing weight onto the inner circumference of a vehicle wheel.

Furthermore, the present claimed invention does not involve the "mere duplication" of parts "without changing the operation and performance of the apparatus", because the arrangement of plural receivers actually does change the operation and performance of the apparatus, as discussed above (also see the present specification at page 7 line 1 to page 8 line 25). The prior art does not disclose and would not have suggested this significantly improved operation and performance, which results from the special provision of plural receivers as now claimed.

The Examiner further refers to the Genma reference for disclosing a welding device with electrodes. It is significant, that Genma also discloses only a single lower electrode (E2) that carries a single metallic piece (P) as a balancing weight. Genma would not have suggested the provision of plural receivers for receiving plural balancing weights in a single gripper-like device. To the contrary, it appears that Genma provides plural gripper-like devices (G, G, G) that each carry one receiver for a single balancing weight, when it is necessary to apply plural balancing weights at plural locations on a rotor shaft (see Fig. 1 showing three gripper-like devices G).

Thus, it is apparent from the disclosure of Genma, that a person of ordinary skill in the art would not have recognized or expected the significant improvements in the operation and performance of the apparatus, which are now achieved by the

present invention by providing plural receivers for plural balancing weights on a single gripper-like device, as discussed above. Directly to the contrary, a person of ordinary skill in the art would have understood that it is necessary to provide plural gripper-like devices when it is desired to carry and apply plural balancing weights. The apparatus according to Genma is thus much more expensive and complicated, and would not have suggested the advantages of the present invention.

Because Ertl provides only a single holding structure for a single balancing weight, and Genma provides only a single receiver on each one of plural gripper-like devices, even a combination of such teachings would not have suggested the present inventive provision of plural receivers for receiving plural balancing weights on one gripper-like device. Furthermore, even the arrangement of plural gripper-like devices along the axial direction of the rotor shaft according to Genma would have been contrary to the present inventive feature of arranging the receivers one after another in a transverse direction and making the receivers jointly moveable in this transverse direction. The references have no pertinent teachings.

The dependent claims are patentable already in view of their dependence from claim 1.

For the above reasons, the Examiner is respectfully requested to withdraw the rejection of claims 7 and 14 to 18 as obvious over Ertl in view of Genma.

- 9) New independent claim 19 is directed to an apparatus for fastening balancing weights onto a periphery of a rotor. The



apparatus comprises two arms arranged so as to receive the rotor therebetween. A counter support surface is provided on one arm, and a row of receivers is provided on the other arm. The receivers form a row arranged one after another in a transverse direction, relative to the longitudinal direction of the rotor, and the receivers are jointly movable in the transverse direction. The receivers are configured to receive plural balancing weights. Thereby, the movable receivers can move any selected one of the balancing weights into a working position, for the selected weight to be fastened to the rotor. In view of the above discussion of the prior art disclosures, it is apparent that the prior art does not disclose and would not have suggested these features as recited in claim 19.

- 10) Favorable reconsideration and allowance of the application, including all present claims 1 to 4, 7 and 9 to 19, are respectfully requested.

Respectfully submitted,  
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Applicant

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